

REMARKS

Reconsideration is requested.

Claims 1-53 have been canceled, without prejudice.

Claims 1-96 have been added and are pending. Independent claim 54 finds support, for example, in originally-filed claims 1 and 11. Support for independent claim 75 may be found, for example, in originally filed claims 26 and 35. Support for independent claim 76 may be found, for example, in originally-filed claim 26. The dependent claims find support in the originally-filed claims and specification. No new matter has been added.

The Examiner is requested to acknowledge receipt of the certified copies of the priority documents filed September 22, 2003.

The Examiner is requested to acknowledge acceptance of the drawings filed September 22, 2003 or specific objection and/or rejection of the same.

Return of an initialed copy of the PTO-1449 Form filed February 11, 2004, pursuant to MPEP § 609, is requested.

The applicants affirm the election of the subject matter of the Examiner's Group I. The pending claims are submitted to read on the Examiner's Group I.

The provisional obviousness-type double patenting rejection of claims 1-21 and 26-49 over claims 1-22 and 27-48 of co-pending application Serial No. 10/713,226 is moot in view of the above-cancellation of the provisionally-rejected claims.

The Rule 75 objection of claims 17, 18, 21, 42, 43, 44, 45, 48 and 49 is moot in view of the above amendments. The pending claims are submitted to be properly dependent.

The Section 102 rejection of claims 1-6, 8-10, 12-16, 19, 20, 26-30, 32-34, 36-41 and 46-47 over Kato (U.S. Patent No. 6,440,203) is moot in view of the above amendments. The claims are submitted to be patentable over Kato and consideration of the following in this regard is requested.

The Examiner has acknowledged that the subject matter of now-canceled claims 7 and 11 is patentable over Kato. Independent claim 54, and claims dependent therefrom, have been drafted to include the subject matter of now-canceled claims 11 and 7, respectively, including any intervening claims. The pending claims are submitted to be recognized by the Examiner to be patentable over Kato.

Kato teaches an ink composition which requires, among other things, a first colorant and a second colorant. See, column 2, lines 33-35 of Kato. The first colorant of Kato is a pigment which has been rendered dispersible and/or dissolvable in water without any dispersant. See, column 2, lines 38-41 of Kato. The second colorant of Kato is a pigment dispersion which contains a pigment and a dispersant for dispersing the pigment. The second colorant of Kato includes a pigment which is not dispersed in the absence of a dispersant. See, column 3, line 66 through column 4, line 4 of Kato.

The claims are submitted to be patentable over Kato.

The Section 103 rejection of claims 1-10, 15, 16, 19, 20, 26-34, 39-41, 46 and 47 over Yatake (U.S. Patent No. 5,746,818) is moot in view of the above.

The claims are submitted to be patentable over Yatake and consideration of the following in this regard is requested.

By the Examiner's own admission, Yakate fails to teach the properties required by the claimed ink compositions. See, page 7 of the Office Action dated September 23,

2004. Moreover, the applicants submit that Yakate fails to suggest a composition of the claims. The Examiner's "position" (id) appears to be relying on an allegation of inherency (i.e., "it would have been obvious....that the ink composition [of the cited art]....would have similar properties..."), which is inappropriate as a basis for a Section 103 rejection, as opposed to an assertion that it would have been allegedly been obvious to have modified the compositions of Yatake to have made the presently claimed invention.

The Examiner is urged to appreciate that obviousness requires some teaching or suggestion in the cited art which would have motivated one of ordinary skill in the art to have made the claimed invention, with a reasonable expectation of success. Yatake fails to provide any such motivation. Moreover, inherent anticipation requires a demonstration or reasonable suggestion that the claimed compositions necessarily flow from the cited art. The Examiner has not established that claimed invention is taught by the cited art. The claims are submitted to be patentable over Yatake.

The Section 103 rejection of claims 1-10, 15, 16, 19, 20, 26-34, 39-41, 46 and 47 over Hayashi (U.S. Patent No. 6,500,248) is moot in view of the above.

The claims are submitted to be patentable over Hayashi and consideration of the following in this regard is requested.

As with the rejection based on Yatake, the Examiner appears to be relying on an alleged inherent teaching of Hayashi ("However it is the position of the Examiner that it would be [sic, have been] obvious to one of ordinary skill in the art that the ink composition as taught by Yatake [sic, Hayashi] would have similar properties as claimed by Applicant absence [sic, absent] evidence to the contrary." See, page 8 of the Office

Action dated September 23, 2004) to allege that the claimed invention would have been obvious from Hayashi. There is no teaching or suggestion of the presently claimed invention in Hayashi.

Unlike Yatake, Hayashi does at least teach a surface tension of the disclosed ink compositions (i.e., not more than 40 mNm⁻¹ at 20°C (see, column 2, lines 59-60 of Hayashi)). Hayashi does not however teach whether the cited surface tension is a static or dynamic measurement. More importantly, Hayashi fails to teach or suggest the relationship between static and dynamic surface tension of the claimed invention. The cited art fails to teach or suggest the unexpected beneficial properties provided by the claimed invention, as exemplified by the present disclosure. The Examiner is requested to see, for example, Table 2 on page 75 of the present disclosure, which provides examples of the claimed invention and comparative examples wherein both the static surface tension and dynamic surface tension are each less than 40 mN/m. Unexpected benefits however are demonstrated where the exemplified compositions satisfy the claimed relationship between the dynamic surface tension and static surface tension.

The claimed invention is patentable over Hayashi.

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned in the event anything further is required.

Respectfully submitted,

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